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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,771	02/18/2004	Harald Schaty	A-10035	1637

181 7590 01/18/2007
MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/779,771	Applicant(s) SCHATY, HARALD	
	Examiner Alicia Chevalier	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

Request for Continued Examination

1. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on November 6, 2006 is acceptable and a RCE has been established. An action on the RCE follows.
2. Claims 1-7 is/are pending in the application, claims 5 and 6 are withdrawn from consideration.
3. Amendments to the claims, filed on November 6, 2006, have been entered in the above-identified application.

REJECTIONS

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 112

23. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In

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the instant case amended claim 7 contain(s) the limitation “wherein the rough adhesive material contact surfaces occupy the entirety of the opposite sides of the disk-shaped object.” The examiner is unable to find support for this limitation in the specification, therefore this limitation is considered new matter.

Claim Rejections - 35 USC § 103

6. Claims 1, 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaki et al. (U.S. Patent No. 6,090,463) and evidences by U.S. Patent No. 5,552,177, U.S. Patent No. 5,735,889, and U.S. Patent No. 5,792,176.

Sakaki discloses an object (*title*) of synthetic thermoplastic adhesive material (*col. 5, lines 14-30*). The object has a contact surface that is rough, where Rz is in a range from 40μ to 100μ, more specifically 55μ to 70μ (*col. 3, lines 24-25*). The rough adhesive material is deemed to contact surfaces occupy the entirety of the opposite sides of the disk-shaped object.

Sakaki fails to disclose that the adhesive device is disk-shaped.

It would have been an obvious matter of design choice to change the shape of adhesive, since a modification would have involved a mere change in size of the adhesive. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). Furthermore, one of ordinary skill in the art would have been motivated to change shape in order adapt the adhesive to different surfaces. As evidenced by U.S. Patent No. 5,552,177, U.S. Patent No. 5,735,889, and U.S. Patent No. 5,792,176 adhesives can be made in to disk shapes to suit different user needs.

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The limitation “for use as an intermediate between parts” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

7. Claims 1, 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itada et al. (U.S. Patent No. 6,638,602) and evidences by U.S. Patent No. 5,552,177, U.S. Patent No. 5,735,889, and U.S. Patent No. 5,792,176.

Itada discloses an object (*title*) of synthetic thermoplastic adhesive material (*col. 5, lines 14-30*). The object has a contact surface that is rough, where Rz is in a range from 40 μ to 100 μ , more specifically 55 μ to 70 μ (*col. 5, lines 58-59*). The rough adhesive material is deemed to contact surfaces occupy the entirety of the opposite sides of the disk-shaped object.

Itada fails to disclose that the adhesive device is disk-shaped.

It would have been an obvious matter of design choice to change the shape of adhesive, since a modification would have involved a mere change in size of the adhesive. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). Furthermore, one of ordinary skill in the art would have been motivated to change shape in order adapt the adhesive to different surfaces. As evidenced by U.S. Patent No. 5,552,177, U.S. Patent No. 5,735,889, and U.S. Patent No. 5,792,176 adhesives can be made in to disk shapes to suit different user needs.

The limitation “for use as an intermediate between parts” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product

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is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

8. Claim 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itada et al. (U.S. Patent No. 6,638,602) as applied above, and further in view of Mascarenhas et al. (U.S. Patent No. 5,888,615).

Itada is relied upon as described above.

Itada fails to disclose the arithmetic mean roughness Ra lines in the range from 6 μ to 25 μ , more specifically 10 μ to 15 μ .

Mascarenhas teaches and adherent article with an arithmetic mean roughness Ra lines in the range from 6 μ to 25 μ , more specifically 10 μ to 15 μ (*col. 11, lines 10-14*), so that the article can be easily removed from a substrate without leaving residue (*col. 1, lines 56-59*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to make Itada's article with an arithmetic mean roughness Ra lines in the range from 6 μ to 25 μ as taught by Mascarenhas in order to insure that the article can be easily removed from a target article without leaving a residue.

ANSWERS TO APPLICANT'S ARGUMENTS

9. Applicant's arguments in the response filed November 6, 2006 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

1/9/07


**ALICIA CHEVALIER
PRIMARY EXAMINER**